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S. Zord

PATENT

Attorney Docket: 2207/6033
Assignee: INTEL Corporation

5/10/03

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

Thomas E. WALSH

Serial No.: 09/220,910

Filed: December 24, 1998

For: SYSTEM AND METHOD FOR
AUTOMATICALLY IDENTIFYING
AND ATTACHING RELATED
DOCUMENTS

Examiner: T. VU

Art Unit: 2142

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APPEAL BRIEF

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Appellant respectfully submits this appeal brief in response to the Office Action of December 19, 2002 finally rejecting each of the pending claims 2, 5 through 15, 17 through 21 and 23 through 41. The Notice of Appeal was filed on March 10, 2003. This Appeal Brief is being timely filed, since it is filed on the next business day after the two-month date of May 10, 2003, which fell on a Saturday.

REAL PARTY IN INTEREST

Intel Corporation of Santa Clara, California is the real party in interest of this appeal by virtue of an assignment dated December 9, 1998 and filed concurrently with the present application on December 24, 1998. A copy of the as filed assignment and USPTO stamped return receipt postcard are attached hereto as Appendix A.

Upon a review of the records and files at the USPTO by the Applicant, no recordation of the assignment could be located. Accordingly, Applicant is concurrently resubmitting herewith a copy of the originally filed assignment for recordation by the USPTO.

RELATED APPEALS AND INTERFERENCES

There are no related appeals or interferences.

STATUS OF CLAIMS

Claims 2, 5 through 15, 17 through 21 and 23 through 41 are pending in this application. Appealed claims 2, 5 through 15, 17 through 21 and 23 through 41 are set forth in the attached Appendix B. Claims 2, 17, 23, 27, 30 and 33 are independent, claims 5 through 15 ultimately depend from independent claim 2, claims 18 through 21 ultimately depend from independent claim 23, claims 24 through 26 ultimately depend from independent claim 23, claims 28 and 29 ultimately depend from independent claim 27, claims 31 and 32 ultimately depend from independent claim 30, and claims 34 through 41 ultimately depend from independent claim 33.

In the final rejection, mailed December 19, 2002, the Examiner finally rejected claims 2, 5 through 15, 17 through 21 and 23 through 41 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Appellant regards as the invention (i.e., un-selected indicator or unspecified location is not disclosed in specification). The Examiner also finally rejected claims 2 through 9, 12 through 15, 17 through 21 and 23 through 41 under 35 U.S.C. § 103 as being obvious over U.S. Patent No. 5,526, 520 to Krause in view of U.S. Patent No. 6,372,612 to Watanabe. The Examiner also finally rejected claims 2 through 15, 17 through 21 and 23 through 41 under 35 U.S.C. § 103 as being obvious over U.S. Patent No. 5,675,507 to Bobo, II in view of U.S. Patent No. 5,870,089 to Fabbio.

Upon entry of the After-Final Response pursuant to 37 CFR §1.116, filed on February 10, 2003, claims 2, 5 through 15, 17 through 21 and 23 through 41 are rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to

particularly point out and distinctly claim the subject matter which Appellant regards as the invention. Claims 2, 5 through 15, 17 through 21, and 23 through 41 are also rejected by the Examiner under 35 U.S.C. §112, second paragraph, as being indefinite in that it fails to point out what is included or excluded by the claim language. The Examiner also asserts that these claims are omnibus-type claims. Claims 2, 5 through 15, 17 through 21 and 23 through 41 are the subject of this appeal.

STATUS OF AMENDMENTS

Claims 10, 12, 14, 19, 28 and 29 stand as originally filed. Claims 2, 8, 9, 11, 13, 15, 17, 18, 20, 21 and 23 through 27 were amended and claims 1, 16 and 22 were canceled without prejudice or disclaimer in a response to a first Office Action, filed on November 26, 2001 (Paper No. 3). Claims 2, 5, 6, 7, 17, 23, 27 and 30 were amended, claims 3 and 4 were canceled without prejudice or disclaimer and new claims 31 and 32 were added in a Preliminary Amendment (Paper No. 7) filed concurrently with a Continued Prosecution Application (CPA), filed on April 22, 2002 (Paper No. 6). Claims 2, 5, 6, 7, 9, 17, 23, 27, 30 and 31 were amended and new claims 33 and 41 were added in a response to a first Office Action, filed on October 2, 2002 (Paper No. 9).

The After-Final Response Pursuant to 37 CFR §1.116, filed on February 10, 2003, was not entered, since the Examiner did not believe it placed the application in condition for allowance. However, the Examiner indicated in an Advisory Action dated February 21, 2003 (Paper No. 12) that for purposes of Appeal, the response would be entered and only identified the § 112, second paragraph, rejections would remain upon entry of the After-Final Response. Appendix B sets forth all pending claims in their current form.

SUMMARY OF THE INVENTION

The present invention provides a system and a method for automatically attaching a related secondary document to a primary document based on processing of an un-selected indicator in the primary document.

In accordance with an embodiment of the present invention, a processor processes a primary document containing at least one word to determine that the primary document contains an un-selected indicator that a secondary document should be attached to the primary document. The processor may identify the secondary document associated with the un-selected indicator and attach the secondary document to the primary document.

The detection and identifying operations, in the embodiment, performed by the processor may be automatic so that the operations may be performed without being initiated by the user. However, in accordance with an embodiment of the present invention, the user may disable these operations using the processor with an appropriate configuration command.

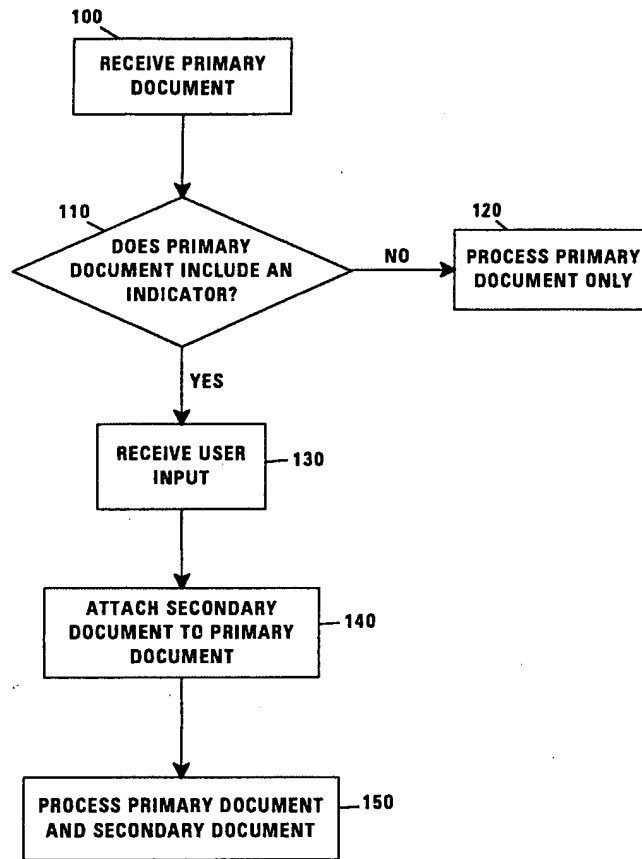
In accordance with the present invention, the indicator may include several different types of indicators. In a first embodiment, the indicator may be one of several individual words or characters that typically indicate that a secondary document should be attached. In a second embodiment, the indicator may be one of a plurality of phrases that may typically indicate that a secondary document should be included. In a third embodiment, the existence of an indicator may be determined by using syntactic processing (otherwise known as natural language processing).

In addition, the present invention may enable the user to add additional terms or phrases to the possible indicators to personalize the system or method for each specific user. Thus, the present invention may allow the user to employ terminology or characters that may not be commonly used. Furthermore, once the system or method according to the present invention determines that a secondary document should be attached, the system or method may also determine either a potential filename or location of the secondary document.

The present invention, including its features and advantages, will become more apparent from the following detailed description with reference to the accompanying drawing.

FIG. 2 (reproduced below) illustrates a top-level functional flow diagram in accordance with an embodiment of the present invention.

FIG. 2



In FIG. 2, a method according to the present invention is depicted. In block 100, a processor 10 may receive primary document 50 from a first storage device 20. In block 110, a **processor 10 may determine whether any of the plurality of words in a primary document 50 is an indicator included in an indicator table 70. If the result of the determination in block 110 is positive, in block 130, processor 10 may then receive a user input indicating the filename and/or the location of a secondary document 60.** In block 140, processor 10 may attach secondary document 60 to primary document 50 for further processing in block 150. If the result of the

determination in block 110 is negative, only primary document 50 may be processed further in block 120.

Although it is no longer used to reject any of the pending claims, a brief discussion of United States Patent No. 5,526,520 to Krause is included to provide a context for the state of the prior art and for the knowledge that one of skill in the art should possess. Specifically, Krause discloses a method and system for organizing and relating a primary document, for example, electronic blueprints, with one or more secondary documents, for example, detailed drawings of specific locations in the electronic blueprint, and automatically displaying the secondary drawings over portions of the primary drawing upon activation (selection by the user) of a hotspot in the primary drawing that is linked to the secondary drawing. (See column 1, line 60 through column 2, line 9.) FIG. 5 from the Krause patent is reproduced below to illustrate the operation of the Krause method and system.

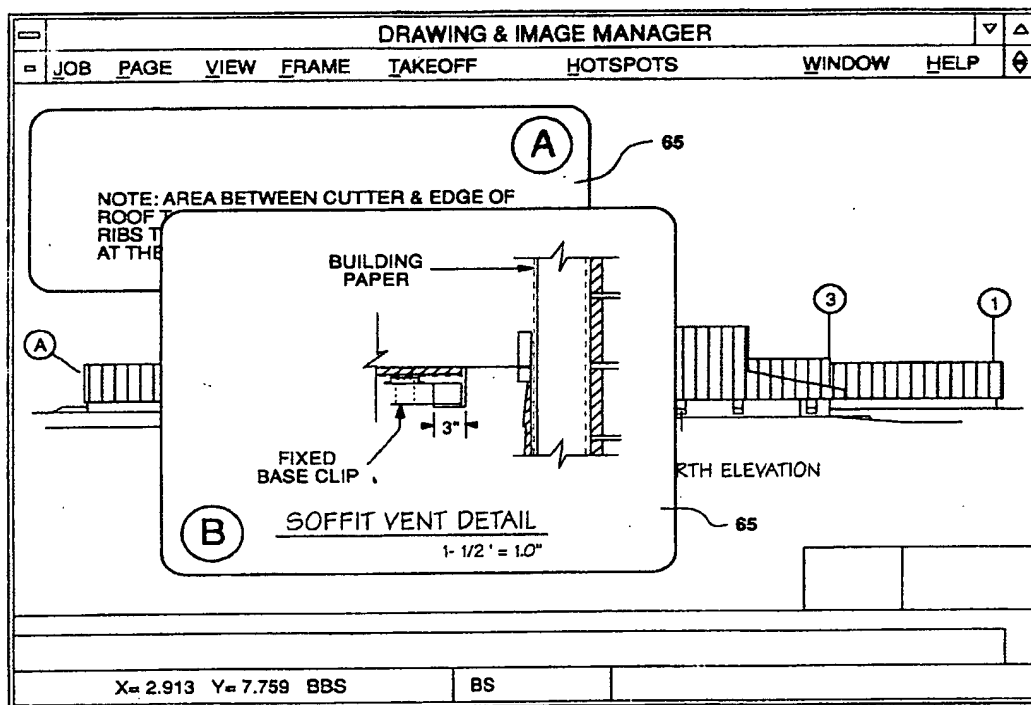


FIG - 5

FIG. 5, is an elevational view of a building drawing that is displayed on display 14 (from FIG. 1) as the primary (i.e., bottom) document, which includes a north elevation view with a number of hotspots drawn as circles with letters or numbers inside the circles. For example, in FIG. 5, hotspot (A) is shown at the left end of the building, hotspot (3) is shown toward the right end of the building and hotspot (1) is shown at the right end of the building. Hotspot (B) is obscured by the detailed drawing display windows 65 for hotspots "A" and "B". FIG. 5 shows the display after the user has activated (i.e., selected) hotspots "A" and "B" 55 by "clicking or actuating [each] hotspot 55 by the mouse/cursor 20, or using the keyboard 16 with cursor/enter" (see column 4, lines 53 through 55). As shown in FIG. 5, the detailed drawing information is displayed over the primary document in a cascade fashion in the order the user activates (selects) the hotspots in the primary drawing.

ISSUES

- Whether the 35 U.S.C. §112, second paragraph, indefiniteness rejection of claims 2, 5 through 15, 17 through 21 and 23 through 41 for failing to particularly point out and distinctly claim the subject matter which Appellant regards as the invention should be reversed.
- Whether the 35 U.S.C. §112, second paragraph, indefiniteness rejection of claims 2, 5 through 15, 17 through 21 and 23 through 41 for being an omnibus-type claim that fails to point out what is included or excluded by the claim language should be reversed.

GROUPING OF CLAIMS

- A. Claims 2, 5 through 15, 31 and 32 are directed to a method for identifying a secondary document having an un-specified location relative to a primary document in a document preparation environment.

- B. Claims 17 through 21 are directed to a document preparation system for identifying a secondary document having an un-specified location from a primary document.
- C. Claims 23 through 26 are directed to a document preparation system for identifying a secondary document having an un-specified location from a primary document.
- D. Claims 27 through 29 are directed to a method for identifying an un-specified address of a recipient of a primary document in a document preparation environment.
- E. Claim 30 is directed to a document preparation system for identifying a secondary document having an un-specified location from a primary document.
- F. Claims 33 through 41 are directed to a method of appending a secondary document, having an un-specified location, to a primary document in a document preparation environment.

The claims do not rise or fall together as is explained in the following argument.

The Pending Claims are not Indefinite

Claims 2, 5 through 15, 17 through 21 and 23 through 41 stand rejected as being indefinite and as being omnibus-type claims.

The rejection of claims 2, 5 through 15, 17 through 21 and 23 through 41 must be reversed because the claims are not indefinite and are not omnibus-type claims.

The following first provides a brief summary of Appellant's argument and, thereafter, provides a detailed discussion of the law and the errors present in the appealed rejections.

ARGUMENT SUMMARY

The present invention provides a method and apparatus for processing a primary document to determine whether it contains an un-selected indicator that a secondary document should be attached to the primary document, identifying the secondary document and attaching the secondary document to the primary document. For example, independent claim 2 recites among other features, “processing said primary document to locate an un-selected indicator; identifying said secondary document associated with said un-selected indicator; and attaching said secondary document to said primary document to encapsulate said secondary document within said primary document.”

Appellant respectfully submits that the Examiner’s rejection of Claims 2, 5 through 15, 17 through 21 and 23 through 41 under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Appellant regards as the invention is unsupportable. The rejection is in error because, although the terms “un-specified location” and “un-selected indicator” do not literally appear in the specification, the Examiner has not properly analyzed the claims. Specifically, the Examiner is required to examine the claims “in light of: (A) The content of the particular application disclosure; (B) The teachings of the prior art; and (C) The claim interpretation that would be given by one possessing the ordinary level of skill in the pertinent art at the time the invention was made.” See, e.g., Solomon v. Kimberly-Clark Corp., 216 F.3d 1372, 1379, 55 USPQ2d 1279, 1283 (Fed. Cir. 2000).” See MPEP § 2173.02. Doing so, results in finding that the indicator in the present application is clearly an “un-selected indicator,” since the indicator is not “selected” by the user but, instead is identified by the processor by “processing said primary document to locate an un-selected indicator,” as recited in claim 2. See also, specification page 4, lines 9 through 11 (“ . . . processor 10 determines whether any of the plurality of words in the primary document 50 is an indicator included in the indicator table 70.”).

Similarly, the phrase “un-specified location” is clearly and unambiguously defined by, at least, the description of FIG. 2, which states that “**processor 10 may receive a**

user input indicating the filename and/or location of a secondary document 60” (see page 4, lines 12 through 13). In contrast, neither is true for a secondary document in the Krause patent, since the hotspot must be predefined with a **specified location** of the secondary document and the hotspot must be **selected** by the user before the secondary document is displayed over the primary document. Therefore, given the claim language, the specification, prosecution history and prior art it would be plainly clear and unambiguous to one of skill in the art what “un-selected indicator” and “un-specified location” mean, as recited in claims 2, 5 through 15, 17 through 21 and 23 through 41. Accordingly, the specification and prosecution history **do** clearly and unambiguously point out and distinctly claim the subject matter of the present invention and are not indefinite.

Appellant also respectfully submits that the Examiner’s rejections of Claims 2, 5 through 15, 17 through 21 and 23 through 41 under 35 U.S.C. §112, second paragraph, as being indefinite in that it fails to point out what is included or excluded by the claim language is in error, and the Examiner’s assertion that the claims are omnibus-type claims, is unsupportable. The claims do not define the invention entirely, or even partially, by reference to the specification and/or drawings as required by Ex Parte Fressola, 27 USPQ2d 1608, 1609 (Bd. Pat. App. & Inter. 1993)) and described in MPEP § 2173.05(r).

Therefore, Appellant respectfully submits that the Examiner’s Section 112, second paragraph, rejection can not be maintained based on the above arguments. Accordingly, the Examiner’s 35 U.S.C. § 112, second paragraph, rejections of claims 2, 5 through 15, 17 through 21 and 23 through 41 must be reversed.

DISCUSSION OF THE LAW

Indefiniteness

To establish indefiniteness of a claimed invention, the

“[d]efiniteness of claim language must be analyzed, not in a vacuum, but in light of:

- (A) The content of the particular application disclosure;
- (B) The teachings of the prior art; and
- (C) The claim interpretation that would be given by one possessing the ordinary level of skill in the pertinent art at the time the invention was made.

In reviewing a claim for compliance with 35 U.S.C. 112, second paragraph, the examiner must consider the claim as a whole to determine whether the claim apprises one of ordinary skill in the art of its scope and, therefore, serves the notice function required by 35 U.S.C. 112, second paragraph. See, e.g., *Solomon v. Kimberly-Clark Corp.*, 216 F.3d 1372, 1379, 55 USPQ2d 1279, 1283 (Fed. Cir. 2000).” See MPEP § 2173.02.

Likewise, it is well settled case law that in order to meet the written description requirement, the specification “need not describe the claimed subject matter in exactly the same terms as used in the claims; it must simply indicate to persons skilled in the art that as of the [filing] date the Appellant had invented what is now claimed.” See All Dental Prodx, LLC et al. v. Advantage Dental Products, Inc., 309 F.3d 774, 779, 64 USPQ2d 1945, ____ (Fed. Cir. 2002) (citing Eiselstein v. Frank, 52 F.3d 1035, 1038, 34 USPQ2d 1467, 1470 (Fed. Cir. 1995) (citing Vas-Cath, 935 F.2d at 1562, 19 USPQ2d at 1115, and In re Wertheim, 541 F.2d 257, 265, 191 USPQ 90, 98 (CCPA 1976))). In fact, “the failure of the specification to specifically mention a limitation that later appears in the claims is not a fatal one when one skilled in the art would recognize upon reading the specification that the new language reflects what the specification shows has been invented.” See All Dental 309 F.3d at 779, 64 USPQ2d at ____ (citing Eiselstein, 52 F.3d at 1039, 34 USPQ2d at 1470. As further stated in All Dental:

The primary purpose of the definiteness requirement is to ensure that the claims are written in such a way that they give notice to the public of the extent of the legal protection afforded by the patent, so that interested members of the public, e.g., competitors of the patent owner, can determine whether or not they infringe. Warner-Jenkinson, 520 U.S. at 28-29. That determination requires a construction of the claims according to the familiar canons of claim construction. Only after a thorough attempt to understand the meaning of a claim has failed to resolve material ambiguities can one conclude that the claim is invalid for indefiniteness. **Foremost among the tools of claim construction is of course the claim language itself, but other portions of the intrinsic evidence are clearly relevant, including the *patent specification and prosecution history*.** See Standard Oil Co. v. Am. Cyanamid Co., 774 F.2d 448, 452, 227 USPQ 293, 296 (Fed. Cir. 1985) (“The specification is, thus, the primary basis for construing the claims. . . . [T]he prosecution history (or file wrapper) limits the interpretation

of claims so as to exclude any interpretation that may have been disclaimed or disavowed during prosecution in order to obtain claim allowance.”). **The prosecution history can thus be relied upon to clarify the claim meaning and hence provide definiteness.** Tex. Instruments Inc. v. Int’l Trade Comm’n, 871 F.2d 1054, 1063, 10 USPQ2d 1257, 1263-64 (Fed. Cir. 1989) (“**The public is entitled to know the scope of the claims but *must look to both the patent specification and the prosecution history*, especially when there is doubt concerning the scope of the claims.**” (citing McGill Inc. v. John Zink Co., 736 F.2d 666, 221 USPQ 944 (Fed. Cir. 1984))).

(Bolding and Italics added by Appellant.) (See All Dental 309 F.3d at 779-780, 64 USPQ2d at ____.)

Omnibus-type Claims

“Claims in utility applications[] that define the invention **entirely** by reference to the specification and/or drawings, [are] so called ‘omnibus’ or ‘formal’ claims . . . [and] are properly rejected under § 112 ¶ 2 as failing to particularly point out and distinctly claim the invention.” (Bolding and underscoring added by Appellant.) (See Ex Parte Fressola, 27 USPQ2d 1608, 1609 (Bd. Pat. App. & Inter. 1993).) Similarly, the MPEP defines an omnibus claim as: “**A device substantially as shown and described.**” (Bolding and underscoring added by Appellant.) (See MPEP § 2173.05(r).)

CLAIMS 2, 5 THROUGH 15, 17 THROUGH 21 AND 23 THROUGH 41 ARE ALLOWABLE

The Examiner has failed to establish a sustainable Section 112, second paragraph, indefiniteness rejection. The Examiner’s rejection of claims 2, 5 through 15, 17 through 21 and 23 through 41 must be reversed because the claims are definite and are non-omnibus-type claims.

For example, independent claims 2 and 27 recite, among other features:

- processing said primary document to locate an un-selected indicator;
- identifying said secondary document associated with said un-selected indicator; and
- attaching said secondary document to said primary document to encapsulate said secondary document within said primary document.

Similarly, independent claims 5, 17, 23, and 30 recite, among other features:

- a first storage device to store said primary document;
- a second storage device to store said secondary document;
- a third storage device to store an indicator; and
- a processor coupled to said first storage device, said second storage device and said third storage device, said processor to process said primary document to locate an un-selected indicator, identify said secondary document associated with said located un-selected indicator, and attach said secondary document to said primary document to encapsulate said secondary document within said primary document.

Regarding the indefiniteness rejection for failing to particularly point out and distinctly claim the subject matter, which Appellant regards as the invention, contrary to the Examiner's assertions, it is clearly evident from the specification that the indicators in the primary document are processed by the processor to determine whether an indicator is present in the primary document and not "selected" (i.e., **un-selected**) by the user in order to cause the secondary document to be identified in its "**un-specified location**" and attached to the first document. (See Specification page 4, lines 7 through 14.) This distinction is further reinforced by reading the Krause patent. In the Krause patent, not only must the "hotspot" be selected by the user before the secondary document (e.g., detailed drawing section) can be displayed, but the selected indicator must contain a known (i.e., specified) location for the secondary document. (Column 4, lines 24 to 65.) In contrast, the specification in the present application is replete with clear examples of indicators that are **not selected** (i.e., are **un-selected**) by the user during operation of the system of the present invention. For example,

Typically, in preparing the e-mail message, the user will include a sentence that notifies the recipient of the existence of the attachment file. For example, the user may include a sentence in the e-mail message such as, "I have attached the budget file . . ." Thus, in this first embodiment, when processor 10 processes the e-mail message, the processor will automatically determine that the word "attached" is one of the entries in indicator table 70. Accordingly, this will indicate to processor 10 that a related document should be attached.

Alternatively, the user may include a predetermined character in primary document 50 that may not typically appear in a document. For example, the predetermined character may be an unprintable control character that will only be included in the document to indicate that a secondary document 60 should be attached.

Once processor 10 detects either type of indicator, processor 10 may then prompt the user to provide the filename and/or the location of the attachment file to attach to the e-mail message. Once the user provides the filename and/or the location of the attachment file, processor 10 may then attach the attachment file to the e-mail message using conventional document management techniques and then send the e-mail message with the attachment file to the recipient.

The processing by processor 10, i.e., detection and attachment, may be performed at any time during or after the creation of primary document 50. The user may be allowed to configure the time at which the processing is performed to suit individual preferences. The user may also be allowed to disable these processes so that the processor does not perform the detection and attachment at all until the user enables these processes at some later point. The system in accordance with the present invention may be implemented as an add-on program to existing conventional programs or be an additional feature incorporated into newer programs. (Page 4, line 25 through page 5, line 17.)

Further examples that the indicators in the primary document are "un-selected" include:

In accordance with the present invention, the indicator may include several different types of indicators. In a first exemplary embodiment, the indicator may be one of several individual word[s] or character[s] that typically indicate that a secondary document should be attached. In a second exemplary embodiment, the indicator may be one of a plurality of phrases that may typically indicate that a secondary document should be included. In a third exemplary embodiment, **the existence of an indicator may be determined by using syntactic processing** (otherwise known as natural language processing). (Page 2, 5th full paragraph.) (Bracketed corrections, bolding and underscoring added by Appellant.)

In addition, the present invention may enable the user to add additional terms or phrases to the possible indicators to personalize the system or method for each specific user. Thus, the present invention may allow a user that employs terminology or characters that may not be commonly used. Furthermore, once the system or method according to the present invention determines that a secondary document should be attached, the system or method may also determine either a potential filename or location of the secondary document. (page 3, 1st paragraph.) (Underscoring added by Appellant.)

The plurality of indicators may include a plurality of predetermined words that are typically used to indicate that a related document should be attached to primary document 50. Some examples of predetermined words include "attached," "enclosed," "included," and "attachment." Those skilled in the art will understand that these are merely examples and that other words or characters may be included in the plurality of indicators without departing from

the scope of the present invention. (Page 4, 1st full paragraph.) (Bolding and underscoring added by Appellant.)

In accordance with the present invention, indicator table 70 may also include phrases or sets of words, instead of individual words or characters, that are typically used to indicate that a related document should be attached. For example, some exemplary phrases may include **"I (or We) have attached," "I (or We) have enclosed," "I (or We) have included," "Please find enclosed," "Attached is the file," etc.** Detecting phrases such as these instead of individual words or characters should result in a reduction of "false-positives" that would occur in the previous embodiments. False-positives occur when the processor detects a word or character included in indicator table 70, but instead of being an indication of a related document, the word or character may merely be just another word in the document. For example, a sentence in primary document 50 may read, "The wheel is attached to the axle of the car." The previous embodiments would detect the word "attached" and determine that a related document should be attached, which would probably not be the case. However, this third embodiment would not determine that a related document should be attached since the phrase "The wheel is attached" would probably not be included in indicator table 70. (Page 6, 1st full paragraph.) (Bolding and underscoring added by Appellant.)

In a further exemplary embodiment of the present invention, the user may be allowed to add additional entries to any of the tables (e.g., indicator table 70, subject table 72 and associations table 74). Thus, the user may further personalize the system by adding slang terms, additional phrases, personalized references, nicknames or associations to the respective tables in accordance with the present invention. (Page 9, 1st full paragraph.) (Underscoring added by Appellant.)

Any of the previous embodiments may be implemented to solve this CC list problem using approaches similar to those discussed above with respect to attaching secondary document 50. One modification may be to change the indicators which are sought to be detected in primary document 50. Instead of words such as "attached," or phrases such as "I have attached," the indicators may include words or phrases indicating that a person/entity should be on the CC list, such as the term "CC" or phrase "I have CC'd." (Page 9, 4th full paragraph.) (Bolding and underscoring added by Appellant.)

Therefore, it would be plainly clear to one of skill in the art that the meaning of the "un-selected indicator" and "un-specified location" recited in the claims is exactly as Appellant has argued. Specifically, the un-selected indicator, for example, a character, word or phrase contained in the primary document, is located during the processing of the primary document by a processor, is **not selected** (i.e., **un-selected**) by the user, in

contrast to the Krause patent, and causes the secondary document to be attached to the primary document. In contrast, in the Krause patent, the user must "select" the predefined hotspot before the secondary document is displayed. Likewise, the location of the secondary document is not contained in the indicator in contrast to the Krause patent where the indicator must contain the location of the secondary document,. It is inconceivable that after reading the specification and the Krause patent, one of skill in the art would not understand the meaning of the "un-selected indicator" and "un-specified location" as recited in the claims. Therefore, the Examiner's rejection of claims 2, 5 through 15, 17 through 21 and 23 through 41 is in error, can not be maintained and should be reversed. Accordingly, the Board of Patent Appeals and Interferences is respectfully requested to reverse the Examiner's Section 112, second paragraph, rejection.

Regarding the indefiniteness rejection for being an omnibus-type claim that fails to point out what is included or excluded by the claim language, contrary to the Examiner's assertions, the claims are not omnibus-type claims. As described in Fressola, an omnibus-type claim "defines the invention **entirely by reference to the specification and/or drawings.**" (See In re Fressola, 27 USPQ2d at 1609.) There is no such language in any of the pending claims that claims the invention "entirely by reference to the specification and/or drawings," or for that matter, even partially by reference to the specification and/or drawings. Therefore, claims 2, 5 through 15, 17 through 21 and 23 through 41 are definite and the Examiner's rejection thereof is in error, can not be maintained and should be reversed. Accordingly, the Board of Patent Appeals and Interferences is respectfully requested to reverse the Examiner's Section 112, second paragraph, rejection.

It is respectfully submitted that a legally sufficient case of indefiniteness for failing to particularly point out and distinctly claim the subject matter which Appellant regards as the invention has not been established by the Examiner for independent claims 2, 17, 23, 27, 30 and 33. Similarly, a legally sufficient case of indefiniteness for being an omnibus-type claim that fails to point out what is included or excluded by the claim language has also not been established by the Examiner for independent claims 2, 17,

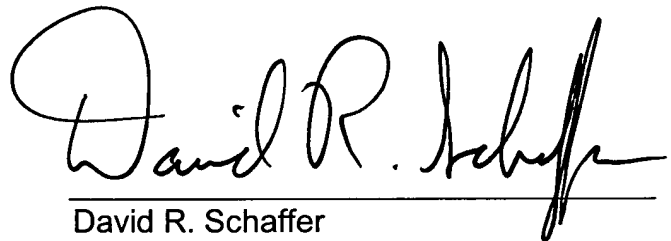
23, 27, 30 and 33. Therefore, for at least the reasons detailed above, claims 5 through 15, 18 through 21, 24 through 26, 28, 29, 31, 32 and 34 through 41, respectively depending from the independent claims are also definite. Accordingly, the Board of Patent Appeals and Interferences is respectfully requested to reverse all of the Examiner's rejections.

SUMMARY

In view of the above, Appellant submits that all claims on appeal are definite. Appellant therefore respectfully requests that the Board of Patent Appeals and Interferences reverse the Examiner's rejections of claims 2, 5 through 15, 17 through 21 and 23 through 41 and direct the Examiner to pass the case to issue.

The Commissioner is hereby authorized to charge the appeal brief fee of \$320.00 plus any additional fees, which may be deemed necessary for consideration of this paper to Kenyon & Kenyon **Deposit Account No. 11-0600**. A duplicate copy of this sheet is enclosed for that purpose.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "David R. Schaffer", written over a horizontal line.

David R. Schaffer
Registration No. 43,089

Date: May 12, 2003

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Enclosure: Appendix A

APPENDIX A

(Brief of Appellant

U.S. Patent Application Serial No. 09/506,436)

(Copies of Originally filed Assignment form and Recordation Cover Sheet and
copy of USPTO-Stamped return receipt postcard filed with Original Assignment form.)

Enclosure: Appendix A

EL17^951881US

The stamp of the Patent Office hereon, may be taken as
acknowledging the receipt, on the date stamped, of

PATENT APPLICATION of Walsh, T.E.

System and Method for Automatically
Title Identifying and Attaching Related Documents

Specification 16

Assignment yes

No. of claims 30

Recording fee \$ 40.00

No. of drawings 7

Authorization to charge Dep. Acct. 11-0600

Declaration yes

Priority Document

Filing fee \$ 1,096.00

Preliminary Amendment

~~5510-5-PTO~~
09/220910

Small Entity

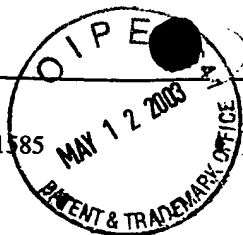
MMC


12/24/98

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FORM PTO 1585



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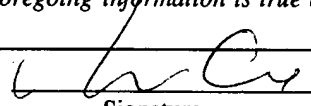
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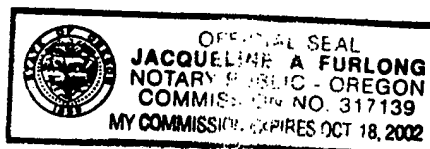
Thomas E. Walsh
Name: Thomas E. Walsh

Each Inventor: Please also list the date that you signed the accompanying DECLARATION AND POWER OF ATTORNEY:

12/9, 19 98
Date

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Rev. 03/13/95

Enclosure: Appendix B

APPENDIX B

(Brief of Appellant
U.S. Patent Application Serial No. 09/506,436)

CLAIMS ON APPEAL

2. A method for identifying a secondary document having an un-specified location relative to a primary document in a document preparation environment comprising:

processing said primary document to locate an un-selected indicator;

identifying said secondary document associated with said un-selected indicator;

and

attaching said secondary document to said primary document to encapsulate said secondary document within said primary document.

5. The method according to claim 2, wherein said un- selected indicator includes at least one word, and wherein said identifying said secondary document is performed as a function of said at least one word.

6. The method according to claim 2, wherein said un-selected indicator includes a plurality of words, and wherein said identifying said secondary document is performed as a function of said plurality of words within a predetermined proximity of said un-selected indicator included in said plurality of words.

7. The method according to claim 2, further comprising:
associating a predetermined word with at least one of a filename and a location of said secondary document,
wherein said primary document includes said predetermined word, and wherein identifying at least one of said filename and said location of said secondary document is performed as a function of said predetermined word.
8. The method according to claim 2, wherein said indicator includes at least one of a plurality of predetermined words, a plurality of predetermined characters, and a plurality of predetermined phrases.
9. The method according to claim 2, wherein processing said primary document to locate said unselected indicator is performed using syntactic processing.
10. The method according to claim 2, wherein said primary document includes an e-mail message.
11. The method according to claim 10, further comprising sending said e-mail message and said secondary document attached thereto to a recipient via a communications device.
12. The method according to claim 2, further comprising sending said primary document and said secondary document attached thereto to a printing device.
13. The method according to claim 2, further comprising sending said primary document and said secondary document attached thereto to a recipient via facsimile.
14. The method according to claim 2, wherein said secondary document is attached to said primary document at a first instance, said first instance being determined as a function of user input.

The method according to claim 2, further comprising adding at least one additional indicator to said indicator as a function of a user input.

17. A document preparation system for identifying a secondary document having an un-specified location from a primary document comprising:

- a first storage device to store said primary document;
- a second storage device to store said secondary document;
- a third storage device to store an indicator; and

a processor coupled to said first storage device, said second storage device and said third storage device, said processor to process said primary document to locate an un-selected indicator, identify said secondary document associated with said located un-selected indicator, and attach said secondary document to said primary document to encapsulate said secondary document within said primary document.

18. The system according to claim 17, wherein said secondary document has a filename and a location, wherein said primary document includes at least one word, and wherein said processor determines at least one of said filename and said location of said secondary document as a function of at least one of a user input and said at least one word.

19. The system according to claim 18, wherein a predetermined word is associated with at least one of said filename and said location of said secondary document, wherein said primary document includes said predetermined word, and wherein said processor identifies at least one of said filename and said location of said secondary document as a function of said predetermined word.

20. The system according to claim 17, wherein said indicator includes at least one of a plurality of predetermined words, a plurality of predetermined characters, and a plurality of predetermined phrases.

21. The system according to claim 17, wherein said processor determines if said primary document includes said indicator using syntactic processing.

23. A document preparation system comprising:
a storage device;
a set of instructions stored on the storage device; and
a processor to execute said set of instructions to perform a method to identify a secondary document having an un-specified location relative to a primary document, said method comprising:
processing said primary document to locate an un-selected indicator;
identifying said secondary document associated with said located un-selected indicator; and
attaching said secondary document to said primary document to encapsulate said secondary document within said primary document.

24. The system according to claim 23, wherein said secondary document has a filename and a location, wherein said primary document includes at least one word, and wherein said processor determines at least one of said filename and said location of said secondary document as a function of at least one of a user input and said at least one word.

25. The system according to claim 23, wherein said indicator includes at least one of a plurality of predetermined words, a plurality of predetermined characters, and a plurality of predetermined phrases.

26. The system according to claim 23, wherein said processor determines if said primary document includes said indicator using syntactic processing.

27. A method for identifying an unspecified address of a recipient of a primary document in a document preparation environment comprising:

processing said primary document to locate an un-selected indicator, said primary document having a list of at least one address;

identifying an address of said recipient associated with said located un-selected indicator; and

attaching said address of said recipient to said list of said at least one address to encapsulate said address of said recipient within said primary document.

28. The method according to claim 27, wherein said indicator includes at least one of a plurality of predetermined words, a plurality of predetermined characters, and a plurality of predetermined phrases.

29. The method according to claim 27, wherein said primary document includes at least one address corresponding to at least one recipient to receive said primary document, further comprising attaching said address of said recipient to said list of said at least one address.

30. A document preparation system comprising:

a storage device storing a set of instructions;

a processor executing said set of instructions to identify an unspecified address of a recipient of a primary document, said primary document including a list of at least one address corresponding to at least one recipient to receive said primary document, by:

processing said primary document to locate an un-selected indicator, said primary document having a list of at least one address;

identifying an address of said recipient associated with said located un-selected indicator; and

attaching said address of said recipient to said list of said at least one address to encapsulate said address of said recipient within said primary document.

31. The method of claim 2, wherein said identifying said secondary document comprises using natural language processing techniques.

32. The method of claim 31, wherein said using natural language processing techniques comprises at least one of:

- using word association processing; and
- using probability matching.

33. A method of attaching a secondary document, having an un-specified location, to a primary document in a document preparation environment, the method comprising:

- processing said primary document to locate an un-selected indicator;
- identifying said secondary document associated with said located un-selected indicator; and
- automatically encapsulating said secondary document within said primary document upon identifying said secondary document.

34. The method of claim 33 wherein said identifying said secondary document associated with said located un-selected indicator comprising:

- determining a filename of said secondary document; and
- determining a location of said secondary document.

35. The method of claim 34 wherein said identifying said secondary document associated with said located un-selected indicator further comprising:

- using syntactic processing of said primary document.

36. The method of claim 34 wherein said identifying said secondary document associated with said located un-selected indicator further comprising:

- using a user input.

37. The method of claim 34 wherein said identifying said secondary document associated with said located un-selected indicator further comprising:
using a user selection.

38. The method of claim 34 wherein said processing said primary document to locate an un-selected indicator comprising:
using syntactic processing of said primary document.

39. The method of claim 34 wherein said processing said primary document to locate an un-selected indicator comprising:
processing said primary document to locate one of a plurality of pre-determined words.

40. The method of claim 34 wherein said processing said primary document to locate an un-selected indicator comprising:
processing said primary document to locate one of a plurality of pre-determined phrases.

41. The method of claim 34 wherein said processing said primary document to locate an un-selected indicator comprising:
processing said primary document to locate one of a plurality of pre-determined characters.